

REMARKS

Upon entry of the present amendment, claims 1, 6-7, 10-11, 17, 30, and 32-33 will be pending in the application. Support for the amendments to the claims is found throughout the application as filed. The amendment to claim 1 is supported in original claim 14. Amendments to other claims correct dependencies or clarify the nature of the claimed subject matter without altering the scope of the claim. Accordingly, the present amendments do not introduce new matter.

Applicants do not intend by the present amendments to abandon the subject matter of any claim as originally filed or as amended and expressly reserve the right to pursue such subject matter in one or more duly filed continuing applications.

A. The Rejection of Claims Under 35 U.S.C. §112, First Paragraph, For Asserted Lack of Enablement Has Been Overcome

The Examiner rejected claims 1-6-7, 9-11, 17 and 30-33 under § 112, first paragraph, for asserted lack of enablement. In supporting remarks, the Examiner asserted that "the terms utilized to define said DNA-interacting molecule(s) are not defined by the present specification nor do they have an established meaning in the art." Office Action at pages 2-3. In response, Applicants submit that the rejection has been rendered moot by the present amendments to the claims, which remove all reference to "DNA interacting molecule" or "DNA incorporating molecule." To the extent that the rationale may be applied against the pending claims as amended, or against claims to be pursued in related applications, Applicants traverse.

Applicants respectfully submit that the Examiner has not established a *prima facie* case of non-enablement for any of the pending claims, as amended in Applicants' prior response of September 9, 2003. In that response, it was noted that

Applicants have amended the claims (*see, e.g.*, claim 1) to recite specific steroid hormones linked to **DNA-incorporating molecules**. As amended, the claims are drawn to compounds, and methods for their preparation, that comprise any one of a set of specifically identified, and structurally well known, steroid hormones linked to **DNA-incorporating molecules, a specific type of DNA-interacting molecule**.

Response of September 9, 2003, at page 6 (emphases added).

DNA-incorporating molecules are defined in the application-as-filed. In particular, the application-as-filed recites that, "[t]o achieve 'incorporation' the steroid is conjugated via a suitable spacer to a desoxy-ribonucleotide triphosphate which is then build

into a DNA molecule by a polymerase-mediated protocol, i.e. nick-translation, 5' overhangs filling or PCR incorporation." Specification, page 9, lines 2-9. Accordingly, the claim-recited term, "DNA-incorporating molecule," is expressly defined in the application-as-filed. Applicants submit that one of ordinary skill in the art would understand this express definition as unambiguously defining a "DNA-incorporating molecule" as recited in rejected claims 1, 6-7, 9-11, 17 and 30-33.

Additionally, Applicants again submit that statements made by the Examiner confirm Applicants' position, as established above. In the remarks supporting the rejection, the Examiner relied on support provided in the prior Office Action, wherein the Examiner asserted that a vast number of compounds are encompassed by the claims. The M.P.E.P., however, makes clear that claim scope cannot be equated with indefiniteness (M.P.E.P. § 2173.04). In this instance, the conclusion that any number of compounds, including a vast number, would be embraced by the claims, confirms that the claims are definite.

For all of the foregoing reasons, Applicants submit that the rejection of claims 1, 6-7, 9-11, 17 and 30-33 under 35 U.S.C. § 112, first paragraph, for lack of enablement has been rendered moot or overcome and should be withdrawn.

B. The Rejections of Claims Under 35 U.S.C. §112, Second Paragraph, For Asserted Indefiniteness Has Been Overcome

The Examiner rejected claims 1, 6-7, 9-11, 17, and 30-33 under 35 U.S.C. § 112, second paragraph, for asserted indefiniteness, supporting the rejection by relying on the support for the rejection of these claims for asserted lack of enablement. That support has been addressed in Section A, above, and is incorporated herein. In response, Applicants submit that the rejection has been rendered moot by the present amendments to the claims and, to the extent this basis for rejecting the claims is maintained against any pending claim or is to be applied against analogous claims in related applications, Applicants traverse.

The term previously recited in the rejected claims is "DNA incorporating molecule." As explained above, that term is expressly defined in the application-as-filed. A "DNA incorporating molecule" is a desoxy-ribonucleotide triphosphate which is built into, or incorporated into, a DNA molecule using a polymerase-mediated protocol. See specification, page 9, lines 2-9. The application further explains that the desoxy-ribonucleotide triphosphate may be attached to a suitable spacer, which in turn is conjugated to a steroid. This disclosure cannot be reconciled with the Examiner's assertion that the term is not defined by the present application. Moreover, Applicants re-submit that a "DNA incorporating

molecule" is self-defining -- one of skill in the art would understand that the recitation of a "DNA incorporating molecule" in the amended claims refers to a molecule that is incorporated into a DNA molecule. A classic example of such a molecule is a desoxy-ribonucleotide triphosphate, or deoxyribonucleoside triphosphate, which comprise the monomeric building block of a DNA molecule. In this regard, Applicants clarify that the identification of the triphosphate form of a DNA monomer as the building block of DNA would be understood by the person of skill in the art as identifying the compound to be incorporated, with the form actually incorporated typically being the monophosphate form of that compound.

For the foregoing reasons, Applicants submit that the rejection of claims 1, 6-7, 9-11, 17, and 30-33 under 35 U.S.C. § 112, second paragraph, for indefiniteness, has been rendered moot or overcome and should be withdrawn.

C. The Objection to Claim 14 Has Been Rendered Moot

The Examiner objected to claim 14 as being dependent upon a rejected base claim. In response, Applicants submit that the objection has been rendered moot by the present amendment to claim 1, incorporating the subject matter of claim 14, and by the cancellation of claim 14. Accordingly, the objection to claim 14 should be withdrawn.

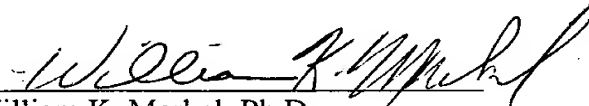
D. CONCLUSION

Applicants respectfully request that the Examiner exercise her discretion and enter the present amendments. In view of the present amendment and remarks, moreover, Applicants submit that claims 1, 6-7, 10-11, 17, 30, and 32-33 are in condition for allowance and request expedited notification thereof.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN

By


William K. Merkel, Ph.D.
Reg. No. 40,725
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-6300

January 13, 2004